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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,999	08/20/2001	Frank-Rainer Bohm	FA-1022	8379

7590 06/24/2004  
E I du Pont de Nemours & Company  
Legal Patents  
Wilmington, DE 19898

EXAMINER
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BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/913,999	<b>Applicant(s)</b> BOHM ET AL.	
	<b>Examiner</b> Melanie D. Bissett	<b>Art Unit</b> 1711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13, 15-18, 20 and 23-26 is/are rejected.
- 7) ☒ Claim(s) 14, 19, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The prior art rejections have been withdrawn based on the applicant's amendments. However, a new prior art rejection has been included, as necessitated by amendment. The rejections based on 35 USC 112 have also been withdrawn based on the applicant's amendments.

***Terminal Disclaimer***

2. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

a. The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

3. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

4. Regardless, the double patenting rejection has been withdrawn based on the abandonment of the cited application, 10/032,858.

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 13, 15-18, 20, and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Roesler et al. as evidenced by Majumdar et al.

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7. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Note, however, that the filing date of Roesler predates the present foreign priority application.

8. Roesler discloses coatings of polyurethane/urea dispersions having alkoxysilane groups, where the alkoxysilane groups are reactive with up to 70% by weight of dispersed colloidal silica (abstract; col. 11 lines 18-38). The reference teaches applying the coatings to metallic substrates, which are inherently electrically conductive (col. 11 lines 39-56). The examples show binder mixed with colloidal silica in varied amounts, where Ludox AM is used as the colloidal silica. The discussion of silane/silica interaction and the heating of the mixed coating compositions in the examples indicate that the binder and silica dispersions are cured after coating. Majumdar indicates that Ludox AM has a particle size within the claimed range (col. 5 lines 36-43). From the discussion of surface modification of Ludox AM silica particles in Majumdar et al., it is the examiner's position that one of ordinary skill in the art would clearly envision the hydroxyl groups being present in the applicant's broad range of "up to 98 wt.%".

Regarding the limitation calling for high partial discharge resistance, it is noted that the applicant has not defined what the applicant considers "high". Thus, the term is given its broadest interpretation. Since the reference teaches the reaction of inorganic and organic materials to form the claimed inorganic-organic-oxygen network, it is the examiner's position that the materials would inherently possess an amount of partial discharge resistance. Without further definition, it is the examiner's position that any

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amount of partial discharge resistance can be considered "high" partial discharge resistance.

9. Claims 15-16 limit  $R_3$  and  $R_4$ , respectively, without limiting the reactive particles to contain additional radicals  $R_3$  and  $R_4$ . Since the silica particles of the reference do not seem to have additional functionality,  $R_3$  and  $R_4$  would not be present, and the further limitations of each additional radical provide no patentable weight over the prior art. In other words, the reference anticipates the claims since the radicals specified are not present.

10. Regarding the coating structure, it is noted that the coatings are indicated as single layer coatings on a substrate. Thus, the coatings can be considered base coats or top coats by the broadest interpretation of the claims.

#### ***Allowable Subject Matter***

11. Claims 14, 19, and 21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

13. The closest prior art, Roesler et al., discloses coating compositions comprising a binder component and a colloidal silica. However, the reference does not teach the claimed functional groups on the reactive particles, the claimed monomeric or polymeric

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additives, or the claimed wire substrate. It is the examiner's position that the cited claims provide a novel and unobvious step over the prior art.

### ***Response to Arguments***

14. Applicant's arguments with respect to claims 13-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

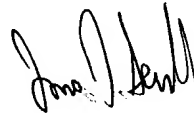
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdb



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700